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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,654	06/26/2003	Steven Smith	237568US17CONT	4025
22850	7590	06/03/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 06/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

# Office Action Summary

Application No.

10/603,654

Applicant(s)

SMITH ET AL.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06282003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Claim Objections*

1. Claim 53 is objected to under 37 CFR 1.75 as being a duplicate of claim 52 since both claims include the exact same claim language and depend from the same claim

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5-11 and 13-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyden et al. 5,625,964 in view of Frachey 5,092,060. Lyden et al. '964 discloses all the limitations substantially as claimed including the following: a vamp (see at least Figures 4, 5 and 7); a lower support connected to the vamp (also shown in Figures 4, 5 and 7, at the least); midsole 33; at least one insert 308 mounted in the lower support; the insert including first and second air tight casings (311, 313, 314, 317, 321); the casings having bridging elements located

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between them to allow for flexibility of the casing with respect to one another and the user's foot during use (those portions of the insert located between casings 311, 313, 315, 317 and 321); the pressure in the casings can be below atmospheric pressure (below 14.7 psi, ranges of 1-5 psi noted); the bridging portions are formed with the casings (see col. 16, line 45 to col. 17 line 34) and are "connected" to the casings; hinge member (flexion web located between the casings) which is in alignment with a joint of the wearer's foot; first casing is substantially circular in horizontal cross-section and second casing is substantially arcuate in horizontal cross-section (in as much as that which is shown by the applicant); Lyden et al. '964 does not disclose the elements located within the casings and the limitations directed towards those elements. Frachey et al. '060 teaches that deformable elements 20 can be located within casings to aid with cushioning the impacts of the user's foot with the ground. The deformable members can have bridging members or hinges 20A connecting the elements (at least three as shown) together to aid in transferring the forces from one member to another and better distribute the load. The elements can comprise at least two batteries (see Figure 4), the deformable elements having substantial "oval" horizontal cross-section (since they appear to be "barrel-shaped"). Frachey et al. '060 also teaches that the

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deformable elements can be located in at least one of the heel portion, lateral portion, forefoot portion or metatarsal portion of the lower support (see Figure 1) as well as on the medial border of a sole portion of the article of footwear so as to be positioned substantially beneath an arc portion of the foot (see Figure 1). The forefoot portion comprises two adjacent separate elements with an area of separation therebetween corresponding generally to a metatarsal-phalangeal joint as shown in Figure 1. The forefoot portion has a single element positioned laterally therein (see Figure 1). The longitudinal lines of the batteries of elements are shown to be aligned with the flex lines of the user's foot (i.e. the longitudinal lines of the elements is perpendicular to the longitudinal line of the user's foot).

Frachey et al. '060 also shows a central heel cushioning portion and a lateral cushioning portion connected by the casing which act to hinge these portions together. The heel cushion elements are positioned inward of the perimeter of the sole to allow for full encapsulation of the element in the sole (see Figure 1) with the heel element providing cushioning under the calcaneus portion of the foot and another cushioning element providing cushioning under the first four metatarsal-phalangeal joints of the foot (see Figure 1). The elements of Frachey et al. '060 are substantially

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H-shaped (as best seen in Figure 3) with the barrels providing the legs and the bridging portion providing the cross member of the H.

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place cushioning element, such as those shown in Frachey et al. '060, in the casings of Lyden et al. '964, to aid in better cushioning and supporting the user's foot during use of the insert.

4. Claims 3-4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 11 above in view of Chee 5,384,977. The references as applied to claim 1 above disclose all the limitations of the claims except for the cushioning elements being cored or dimpled. Chee '977 teaches that cushioning elements located within a shoe casing can be cored (as shown in Figure 2, center of elements are hollow) or dimpled (as shown by cone in Figure 3) to allow for the insert in which they are placed to be lighter in weight. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the deformable elements of the references as modified and applied to claim 1, hollow or dimpled, as taught by Chee '977, to lighten the weight of the shoe while still providing the desired cushioning effect.

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### *Conclusion*

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.  
Allowed Files & Publication (703) 305-8322  
Assignment Branch (703) 308-9287

Application/Control Number: 10/603,654

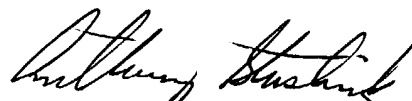
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Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
June 1, 2004